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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,187	03/10/2004	Norbert Rick	MERCK-2862	2740
23599	7590	12/13/2005	EXAMINER	
MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			MARCHESCHI, MICHAEL A	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/796,187

Applicant(s)

RICK ET AL.

Examiner

Michael A. Marcheschi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-20 is/are rejected.
- 7) ☒ Claim(s) 9-12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Although the art relied upon in the below rejection is the same, the examiner has applied a new indefinite rejection~~s~~ and objections and thus this action is not made final.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The limitation “phosphate” as defined in claim 1, layer (D) is not defined in the specification.

The limitations “CVD” or “PVD” process, as defined in claims 16 are not defined in the specification.

Claims 9-12 are objected to because of the following informalities: In these claims “Cr₂O₃” are defined twice.. Appropriate correction is required.

Claims 1-7 and 13-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite as to the limitation “at least one metal oxide, sulfide, telluride...or actinide” because the examiner is unclear as to what “at least one” is referring to. Is it referring

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to (1) only the metal oxide or (2) is it referring to all of the material (i.e. sulfide, telluride selenide, lanthanide, phosphate or actinide.

Claim 18 is indefinite because the examiner is unclear as to what is encompassed by an additive, thus rendering the scope of the claim unclear. It does not appear that any and all additives (i.e. gasoline can be an additive) are within the scope of the claims.

The other claims are indefinite because they depend on indefinite claims.

Claims 1-7 and 9-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Schoen et al. US 2002/0192448 for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 1-7 and 9-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,884,289 for the same reasons defined in the previous provisional ODP rejection (provision ODP rejection was based on this reference as a application) which are incorporated herein by reference. Between the time of the previous office action and the instant office action, copending 10/128,521 (basis for previous provisional ODP rejection) has matured into the above patent, thus the art relied upon is not new.

Applicant's arguments filed 10/6/05 have been fully considered but they are not persuasive.

Applicants argue that, although the reference defines the covering (D) of absorbent particles as a layer, this is clearly different from the layer of the claimed invention. The examiner is unclear as to applicant argument because a claim can be given its broadest interpretation and the applicants do not distinguish the absorbent layer (D) of the instant claims with the absorbent layer of the reference (i.e. reference layer (D) is a layer of absorbent particles, thus broadly reading on the claimed absorbent layer). Applicants also state that it is clear from the specification that the claimed layer is homogeneous layer. Notwithstanding this argument, this is not claimed. Assuming *arguendo*, the examiner is unable to find support for applicants position. Applicants state that the layer of the instant claims is made by wet chemical methods. Although this may be true, so is the absorbent layer of the reference (i.e. section [0057] of the reference defines that a wet method is used). Finally applicants argue that the layer of the reference will give differing reflection properties when compared to the claimed layer. Applicants provide no evidence to support this. Since the layer, as broadly interpreted, can be the same, one would expect the properties thereof to also be the same. In addition, applicants do not claim any properties that might provide a distinction.

A reference is good not only for what it teaches but also for what one of ordinary skill might reasonably infer from the teachings. *In re Opprecht* 12 USPQ 2d 1235, 1236 (CAFC 1989); *In re Bode* USPQ 12; *In re Lamberti* 192 USPQ 278; *In re Bozek* 163 USPQ 545, 549 (CCPA 1969); *In re Van Mater* 144 USPQ 421; *In re Jacoby* 135 USPQ 317; *In re LeGrice* 133 USPQ 365; *In re Preda* 159 USPQ 342 (CCPA 1968). In addition, "A reference

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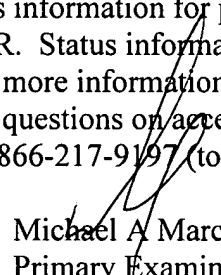
can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments" See *In re Van Marter*, 144 USPQ 421.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

12/05
MM


Michael A. Marcheschi
Primary Examiner
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